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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/937,756

09/25/1997

DAVID C. RUEGER

JJJ-P06-504

2132

7590

05/18/2006

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EXAMINER

TURNER, SHARON L

ART UNIT

PAPER NUMBER

1649

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 08/937,756	<b>Applicant(s)</b> RUEGER ET AL.	
	<b>Examiner</b> Sharon L. Turner	<b>Art Unit</b> 1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 97,99 and 105-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 97,99 and 105-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response to Amendment**

1. The amendment filed 4-12-04 has been entered into the record and has been fully considered.
2. The text of Title 35 of the U.S. Code not reiterated herein can be found in the previous office action.
3. As a result of Applicant's amendment, all rejections not reiterated herein have been withdrawn by the Examiner.
4. Claims 97, 99 and 105-111 are pending.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The Examiner acknowledges the following Terminal Disclaimers over US 6,288,031, 6,194,376, 6,723,698 and 6,506,729 thereby obviating the double patenting rejections over these issued US patents.
7. Claims 97, 99, 105-111 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of 6,949,505, claims 1-30

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of 5,674,844, claims 1-16 of US 6,800,603, claims 1-19 of 5,849,686, claims 1-2 of 6,495,513, claims 1-14 of 6,333,312, claims 1-20 of 5,972,884, claims 1-24 of 5,739,107, claims 1-8 of 6,399,569, claims 1-18 of 5,656,593, claims 1-29 of 5,733,878, claims 1-5 of 6,531,445, claims 1-8 of 6,936,582, claims 1-8 of 6,288,031, and claims 1-25 of 6,281,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims are similarly drawn to administration of the same compound compositions as instantly recited. The preamble recitation, "for decreasing neuronal cell death associated with a neuropathy," of instant claims does not receive patentable weight because the preamble is a statement of intended use and is not linked in any way to the body of the claim. The steps of the instant claims merely comprise "contacting a neuronal cell with a morphogen" as recited in the listed elements. The following "wherein" clause in the body of the claim, is merely a recitation of the inherent properties of such contacting steps. The conflicting claims each recite a contacting or administration step where the noted compounds are provided to a subject that contains neuronal cells and therefore comprises the contacting step. As the contacting step is provided, the conflicting claims constitute a practice of the claimed invention and subsequent patenting would qualify as non-obviousness double patenting. It is further noted that Applicants share an extensive number of similarly owned patents related to instant subject matter. While the Examiner believes that she has reviewed all related patents for such double-patenting issues, the list is so extensive that it is incumbent upon Applicant to share in their duty to disclose and point out where they believe other issues with respect to double patenting may lie,

that have not already been addressed above. The above is believed to be a complete list reciting administration of the claimed compounds to subjects thereby comprising contact with neuronal cells.

### **Status of Claims**

8. No claims are allowed.
9. Applicants are reminded of their duty to disclose. The Examiner notes multiple co-pending applications via instant Inventors, the status of which may change during prosecution on the merits.
10. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (571) 272-0894. The examiner can normally be reached on Monday-Thursday from

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7:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached at (571) 272-0867.

Sharon L. Turner, Ph.D.  
May 15, 2006

  
SHARON TURNER, PH.D.  
PRIMARY EXAMINER  
5-15-06